

STATUS OF THE CLAIMS

Claims 39-51 are pending in the Application.

Claims 39-51 stand rejected.

Claim 39 has been amended, without prejudice, herein.

REMARKS

Response After Final

Entry of this Response is respectfully requested on the ground that this Response places the application in condition for allowance. Alternatively, entry of this Response is respectfully requested on the ground that this Response places the claims in better form and condition for appeal. Furthermore, Applicant submits that any arguments or amendments made regarding the claims do not require an additional search on the part of the Office, nor do any arguments or amendments made herein raise new issues with regard to the patentability of the claims now pending.

Claim Amendments

Applicant has amended Claim 39 to more distinctly claim the subject matter that Applicant regards as the invention. Specifically, the amendment clarifies the positioning of the planar member's second portion in relation to its first portion. This clarification is supported throughout the specification, and more specifically, from page 12, line 12, through page 15, line 12, of the Specification and Figure 18.

Rejections under 35 U.S.C. § 103(a)

Claims 39-41 and 48-50 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins (GB 2,299,568) in view of Cillario (U.S. 4,472,895). Claims 39-42, 48, and 49 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks (GB 2,311,273) in view of Cillario. Claims 43-46 and 51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Cillario as applied to claims 39 and 50, and further in view of Kaufmann (U.S. Patent No. 5,264,265). Claims 43-46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Cillario as applied to claim 39 above, and further in view of Kaufmann. Claim 47 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Cillario and Kaufmann as applied to claim 46, and further in view of Mehta. Claims 47, 50, and 51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Cillario and Kaufmann as applied to claims 46 and 49, and further in view of Mehta. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

Regarding Claim 39, Applicant respectfully submits that the cited references, either separately or in combination, fail to teach or suggest every limitation of the present invention as claimed. Specifically, neither Atkins, Holden-Banks, Cillario, Kaufmann, nor Mehta, alone or in combination, teach or suggest a method for making a device for labeling an object comprising providing a substantially planar member having first and second portions, wherein said second portion abuts a distal end of said first portion, said second portion wrapping around the periphery of said object to overlap at least a portion of said first portion of said planar member.

By the present Office Action, the Examiner contends that, because “both the first and second portions [of Cillario] are on the periphery of the article,” Cillario teaches that “the second portion overlap[s] the first portion around the periphery of the object or article.” (Present Office Action at 11.) Applicant respectfully submits that the present Office Action misrepresents the Cillario reference.

Claim 39 clearly requires that the second portion overlap at least a portion of the first portion *around the periphery of the object*. In contrast, Cillario, teaches a “flap” (6) that is “folded over” a “strip element” (1). (Cillario at column 1, line 48 and column 2, line 5.) The Cillario flap does not overlap *around* the periphery of the object, but simply *over* the strip

element to “reproduce the approximate disposition of a separate greetings card.” (Cillario at column 2, lines 17-18; Figures 1-3.)

Applicant has amended Claim 39 to more clearly distinguish it from the art of record. Specifically, the amendment clarifies that the second portion of the present Application abuts a distal end of the first portion and wraps around the periphery of the object to overlap at least a portion of the first portion. In contrast, Cillario’s “second portion” (flap (6)) does not abut the distal end of its “first portion” (strip element (1)). Rather, the Cillario “flap extend[s] generally *transversally* from the longitudinal axis of the strip element.” (Cillario at column 2, lines 32-34 (emphasis added).) Further, Cillario’s second portion does not wrap around the periphery of the object to overlap at least a portion of the first portion, but is “folded over” the first portion “to reproduce the approximate disposition of a separate greetings card” (Cillario at column 2, lines 5, 15-18.) Similarly, Atkins, Holden-Banks, Kaufmann and Mehta do not teach these elements of Claim 39.

Therefore, for at least the reasons stated above, Applicant respectfully requests reconsideration and removal of the 35 U.S.C. § 103(a) rejections. Applicant further submits that Claims 40-51 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from patentably distinct base Claim 39.

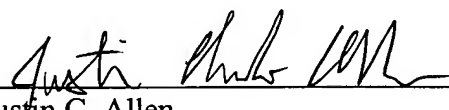
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CONCLUSION

Wherefore, Applicant believes he has addressed all outstanding grounds raised by the Examiner and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

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